

REMARKS

The applicants have carefully considered the official action dated April 29, 2009, and the references it cites. By this response, claims 1-3, 8, 21, 33, 49, 50, and 51 have been amended. In view of the forgoing amendments and the following remarks, it is respectfully submitted that all claims are in condition for allowance and reconsideration is requested.

Rejections Under 35 U.S.C. § 112

Claims 1-45 and 47-51 were rejected as failing to comply with the written description requirement. While applicants do not admit the propriety of the rejection, the claims have been amended to clarify the claimed invention. Querying a user for a phrase that indicates that a communication is not related to a concept and using the phrase in developing a classifier as recited in claims 2 and 8 are described in, at least, FIG. 6 and Paragraphs [0075] and [0083]. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 2 and 8 were rejected as failing to particularly point out and distinctly claim the subject-matter which applicant regards as the invention. In particular, the official action argued that phrase “each group” was not clear. Claims 2 and 8 have been amended for clarification to recite: assessing a first value related to performance that labeling a first set of electronic communications from a first one of a training set group, a system-labeled set, a test set group, a faulty set, or a random set provides to the classifier being developed and assessing a second value related to performance that labeling a second set of electronic communications from a second one of the training set group, the system-labeled set, the test set group, the faulty set, or the random set provides to the classifier being developed. While, as noted in the official action, claims 1 and 3 do not require that an electronic communication from each of the groups is selected, they do not recite that a communication is not selected. Accordingly, it is respectfully submitted that claims 2 and 8 are clear and proper in inherently

reciting labeling of a first set of electronic communications and labeling a second set of electronic communication. Withdrawal of the rejection is respectfully requested.

Claim 35 was rejected for there allegedly being insufficient antecedent basis for the phrase “wherein selecting electronic communications for labeling by the user...” However, claim 35 depends on claim 34, which recites “The computer implemented method of claim 33, wherein (d) and (e), and (f) includes selecting electronic communications for labeling by the user targeted to build the electronic communications classifier within known performance bounds.” (emphasis added). Accordingly, it is respectfully submitted that antecedent basis for the noted recitation can be found in claim 34. Withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 1-45 and 47-48 were rejected as being directed to non-statutory subject-matter. Claims 1-45 and 47-48 are method claims. To be statutory, a method claim must be tied to a particular machine or transform underlying subject matter as noted in the official action. Claims 1-45 and 47-48 are tied to particular machines, namely, computers programmed in particular manners to perform the claimed procedures. The official action argues that the claim cannot be tied to a particular device without specifying the details of the electronic communications. However, this requirement is not supported by the most recent examination guidelines issued by the USPTO.

Page 15 of the “Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101” (included in the appendix to this paper) provides an example claim that is similar in nature to the applicants claims, in which a method for evaluating search results is statutory when one step is tied to a microprocessor. Like the electronic communications of the applicants’ claims, the example claim does not include any

details as to the nature or particulars of the search results. However, it is explicitly noted in the instructions that the claim is statutory. Such a determination is logical because the example claim is not directed to the particulars of the search results, but is directed at the operations that are performed. Likewise, the applicants' claims are not directed to the particulars of the electronic communications, but rather to a computer programmed to perform the processes recited in the claims (e.g., querying, receiving, presenting, developing, deploying, storing, etc.). The programmed computer is a particular machine, regardless of the particulars of the electronic communications. Accordingly, it is respectfully submitted that claims 1-45 and 47-48 are statutory and withdrawal of the rejection is respectfully requested.

Claims 49-51 were rejected as directed to non-statutory subject-matter. The claims have been amended to recite "A tangible computer readable medium storing instructions that when executed cause a computer to develop a classifier for classifying electronic communications by..." in accordance with the Page 11 of the "Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101" such claims are statutory. Likewise, MPEP § 2106.01 indicates the claims are statutory because they recite functional descriptive material recorded on a computer readable medium¹. A claim that recites a tangible computer readable medium storing instructions that when executed cause a computer to perform noted operations is statutory. Accordingly, it is respectfully submitted that claims 49-51 are statutory and withdrawal of the rejection is requested.

¹ "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." (MPEP § 2106.01)

Rejections Under 35 U.S.C. § 102

Claim 1 was rejected as anticipated by Lewis (US 5,675,710). Claim 1 recites, *inter alia*, querying a user for a phrase that indicates that a communication is not related to a concept and developing a classifier for classifying electronic communications based upon the phrase, relevant labels and irrelevant labels assigned by a user during presenting of the electronic communications to the user. Lewis does not teach or suggest such recitations. While Lewis describes receiving a user request that specifies words or attributes that the user believes are likely to occur in relevant documents (Col. 7, lines 42-57), Lewis does not suggest that a user is queried for or submits a phrase that indicates that a communication is not related to a concept and that the phrase would be used in developing a classifier. Furthermore, Lewis does not describe a capability for handling such a phrase that indicates that a communication is not related to a concept. Accordingly, claim 1 and all claims depending therefrom are patentable over the cited art.

Claim 3 recites, *inter alia*, querying a user for a phrase that indicates that a communication is not related to a concept. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not related to a concept. Accordingly, claim 3 and all claims depending therefrom are in condition for allowance.

Claim 21 recites, *inter alia*, developing an expression of labeling criteria in an interactive session with a user, wherein the interactive session includes querying a user to identify a phrase that indicates that a communication is not related to a concept and receiving a user identification of the phrase. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not

related to a concept. Accordingly, claim 21 and all claims depending therefrom are in condition for allowance.

Claim 33 recites, *inter alia*, eliciting labeling criteria from a user by querying a user to identify a phrase that indicates that a communication is not related to a concept and receiving the phrase. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not related to a concept. Accordingly, claim 33 and all claims depending therefrom are in condition for allowance.

Claim 49 recites, *inter alia*, querying a user to identify a phrase that indicates that a communication is not related to a concept. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not related to a concept. Accordingly, claim 49 and all claims depending therefrom are in condition for allowance.

Claim 50 recites, *inter alia*, developing an expression of labeling criteria in an interactive session with the user, wherein the interactive session includes querying a user for a phrase that indicates that a communication is not related to a concept and receiving a user identification of the phrase. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not related to a concept. Accordingly, claim 50 and all claims depending therefrom are in condition for allowance.

Claim 51 recites, *inter alia*, eliciting labeling criteria from a user by querying a user for a phrase that indicates that a communication is not related to a concept and receiving a user identification of the phrase. As described in conjunction with claim 1, Lewis does not teach or suggest querying a user for a phrase that indicates that a communication is not

related to a concept. Accordingly, claim 51 and all claims depending therefrom are in condition for allowance.

CONCLUSION

In general, the official action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the applicants will not address such statements at the present time. However, the applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

In view of the foregoing, the applicants respectfully request reconsideration of this application. If there are any remaining matters that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Deposit Account No. 50-2455.

Respectfully submitted,

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APPENDIX

INTERIM EXAMINATION INSTRUCTIONS FOR EVALUATING SUBJECT MATTER ELIGIBILITY UNDER 35 U.S.C. §101



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IMPLEMENTATION PLAN

- OVERVIEW OF INTERIM EXAMINATION
INSTRUCTIONS FOR SUBJECT MATTER ELIGIBILITY
- INSTRUCTIONS WILL BE POSTED ON USPTO
INTERNET WEBSITE
- TC SPECIFIC TRAINING TO FOLLOW
- QUESTIONS SHOULD BE DIRECTED TO SPEs, THEN
TO TC 101 REPRESENTATIVES



OVERVIEW

TRAINING OVERVIEW:

- THE TWO-STEP 101 ANALYSIS
- PRODUCT FLOWCHART AND EXAMPLES
- PROCESS FLOWCHART AND EXAMPLES



STEP 1

- Is the claim directed to one of the four patent-eligible subject matter categories?
 - Process, Machine, Manufacture, Composition of Matter
- If not in one of the four categories, the claim is not eligible.
 - Examples of claims that are not eligible:
 - Transitory signals *per se*, humans *per se*, a company *per se*, or a set of instructions *per se* (such as a game or software *per se*)



STEP 2

- A claim satisfying Step 1 is subject-matter eligible under 101 unless it wholly embraces a judicially recognized exception.
 - Does the claim wholly embrace a judicially recognized exception?
 - Abstract Idea
 - Law of Nature
 - Natural Phenomena
 - The exceptions also include, for example:
 - Mental Processes
 - Mathematical Algorithms
 - Scientific Principles
- If the claim is directed to a judicial exception itself, it is not eligible.
- A particular practical application of a judicial exception is eligible.



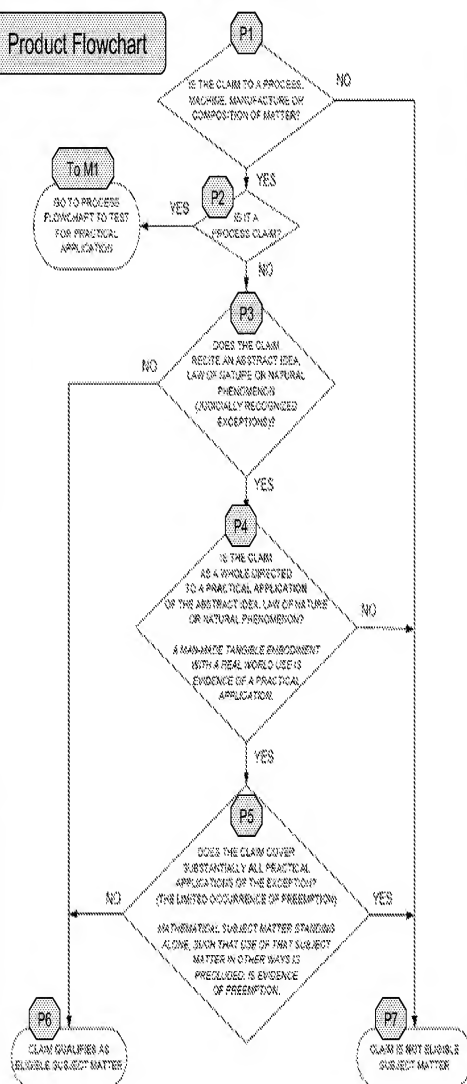
PRODUCT CLAIM ANALYSIS

- Begin with the broadest reasonable interpretation (BRI) of the claim in view of the specification consistent with the interpretation those skilled in the art would reach. MPEP 2111
- Product Focus:
 - Does the claim meet definitions of machine, manufacture or composition of matter?
 - Is there a judicial exception recited in the claim?



SUBJECT MATTER ELIGIBILITY TEST

Product Flowchart





PRODUCT EXAMPLE: CLAIM 1

No Judicial Exception

Claim 1. A hand tool, comprising:

- a handle; and
- a head coupled to the handle having a striking surface and a claw.

- Is the claim directed to a machine or manufacture? (P1)
 - YES - it is an article produced from prepared materials.
- Does it recite a judicial exception? (P3)
 - NO.

➤ The claim is **eligible** (P6).



PRODUCT EXAMPLE: CLAIM 2

Judicial Exception Claimed

Claim 2. A machine for evaluating search results, comprising:

- a microprocessor coupled to a memory,
- wherein the microprocessor is programmed to evaluate search results by:
 - sorting the results into groups based on a first characteristic;
 - ranking the results based on a second characteristic using a mathematical formula [f]; and
 - comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.

- Is the claim directed to a machine? (P1)
 - YES - it is a concrete thing, consisting of parts.
 - Does it recite a judicial exception? (P3)
 - YES - the ranking step includes a mathematical algorithm.
 - Is it directed to a practical application? (P4)
 - YES - evidenced by the tangible embodiment of the microprocessor for evaluating search results, which is a real world use.
 - Is the claim directed to substantially all practical applications of the mathematical algorithm? (P5)
 - NO – the algorithm is limited to use in evaluating search results in the particular claimed machine that is programmed to perform certain steps. As there are other ways to use the algorithm, for example, with different programmed steps, not every use is covered by the claim.
- The claim is **eligible** (P6).



PRODUCT EXAMPLE: CLAIM 3

Computer-Readable Medium

Claim 3. A non-transitory computer-readable storage medium with an executable program stored thereon, wherein the program instructs a microprocessor to perform the following steps:

- sorting results of a search into groups based on a first characteristic;
 - ranking the results based on a second characteristic using a mathematical formula [f]; and
 - comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.
-
- Is the claim directed to a manufacture? (P1)
 - YES - it is an article (a non-transitory storage medium) produced from raw or prepared materials.
 - Does it recite a judicial exception? (P3)
 - YES - it recites a mathematical algorithm.
 - Is it directed to a practical application? (P4)
 - YES - evidenced by the tangible embodiment of the computer-readable storage medium.
 - Is the claim directed to substantially all practical applications of the mathematical algorithm? (P5)
 - NO – there are other substantial uses of the algorithm than using it in evaluating search results in a program stored on the particular claimed manufacture. As there are other ways to use the algorithm, for example, with different programmed steps, not every use is covered by the claim.
- The claim is **eligible** (P6).



COMPUTER-READABLE MEDIA

Additional Information

- The functional/non-functional distinction is not an inquiry under 101. The 101 inquiry is whether a claim directed to one of the four statutory categories is wholly directed to a judicial exception.
- A tangible medium including a computer program should be evaluated to determine if there is a functional relationship between the computer program and the medium for purposes of distinguishing over prior art, not for subject matter eligibility.



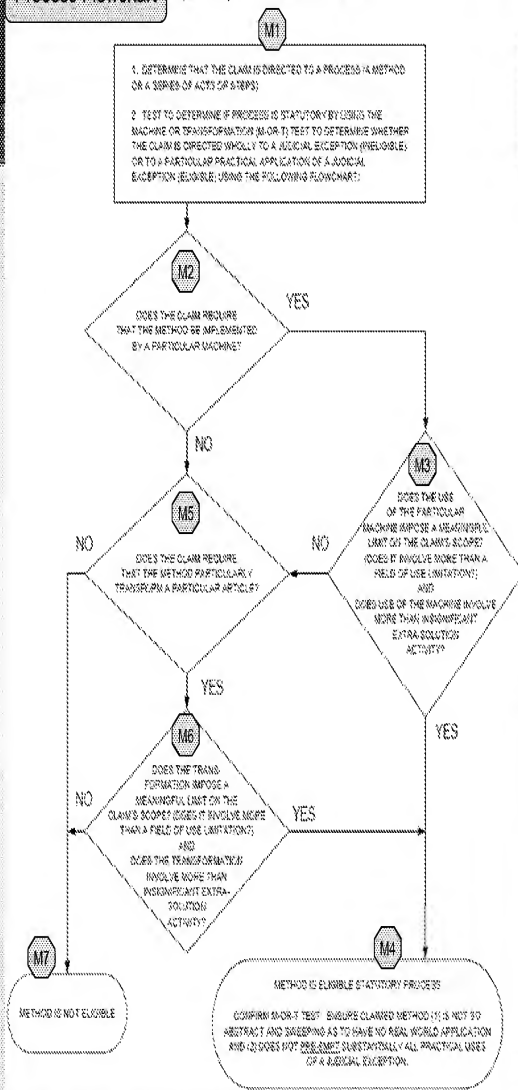
PROCESS CLAIM ANALYSIS

- Begin with the broadest reasonable interpretation (BRI) of the claim in view of the specification consistent with the interpretation those skilled in the art would reach. MPEP 2111.
- Process Focus:
 - Does the claim meet the machine or transformation (M-or-T) test? The claimed process must:
 - (1) be tied to a particular machine or apparatus, or
 - (2) particularly transform a particular article to a different state or thing.
 - Two corollaries: the particular machine or transformation must involve:
 - Meaningful limits
 - More than insignificant “extra-solution” activity



Process Flowchart

SUBJECT MATTER ELIGIBILITY TEST (M-O-T) FOR PROCESS CLAIMS





PROCESS EXAMPLE: CLAIM 4

No Machine or Transformation Claimed

Claim 4. A method of evaluating search results, comprising:

- sorting the results into groups based on a first characteristic;
- ranking the results based on a second characteristic; and
- comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.

Under the BRI, each step could be done by hand or on a programmed computer.

- Is there a particular machine? (M2)
 - NO - there is no machine explicitly recited or inherently required
 - Is there a transformation of an article? (M5) - NO
- Claim is **not eligible** (M7).



PROCESS EXAMPLE: CLAIM 5

Claim Tied to a Particular Machine

Claim 5. A method of evaluating search results, comprising:

- sorting the results into groups based on a first characteristic;
- ranking the results based on a second characteristic; and
- comparing, using a microprocessor, the ranked results to a predetermined list of desired results to evaluate the success of the search.

Under the BRI, the microprocessor must be programmed in a particular manner to perform the claimed comparing step.

- Is there a particular machine? (M2)
 - YES - under the BRI, the step of comparing requires a particularly programmed microprocessor.
 - Does the machine impose a meaningful limit and is it more than insignificant extra-solution activity? (M3)
 - YES - the step of comparing is central to the method invented by applicant – it is not a mere field-of-use or insignificant extra-solution activity.
- The claim is **eligible** (M4).



PROCESS EXAMPLE: CLAIM 6

Extra-Solution Activity

Claim 6. A method of evaluating search results, comprising:

- obtaining the search results by electronically downloading the results from a database;
 - sorting the results into groups based on a first characteristic;
 - ranking the results based on a second characteristic; and
 - comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.
-
- Is there a particular machine? (M2)
 - YES - the step of obtaining the search results inherently requires a programmed microprocessor to download data from a database; under the BRI no other step requires a machine.
 - Does the machine required for downloading impose a meaningful limit and involve more than insignificant extra-solution activity? (M3)
 - NO - the downloading step is not central to the purpose of the method invented by the applicant and is insignificant extra-solution activity.
 - Is there transformation of an article? (M5)
 - NO
- The claim is **not eligible** (M7).



SUMMARY

- The Instructions supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP 2106(IV), 2106.01 and 2106.02, as of 8/24/09.
 - To determine subject matter eligibility, follow the “Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101”.
- Product claims are evaluated to determine if the claim is wholly directed to a judicial exception.
 - Functional/nonfunctional descriptive material (FDM/NFDM) is evaluated for patentable distinction over the prior art. See MPEP 2112.01(III).
- All process (method) claims are evaluated with the M-or-T test.



QUESTIONS

- TC SPECIFIC TRAINING WITH ADDITIONAL EXAMPLES WILL FOLLOW
- QUESTIONS SHOULD BE DIRECTED TO YOUR SPE, THEN TO THE FOLLOWING EMAIL HELP PANELS:
 - TC 1600: 101 Help-TC1600
 - TC 1700: 101 Help-TC1700
 - TC 3600: 101 Help-TC3600
 - TC 3700: 101 Help-TC3700
 - TC 2100: 101 Help-TC2100
 - TC 2400: 101 Help-TC 2400
 - TC 2600: 101 Help-TC2600
 - TC 2800: 101 Help-TC2800



THANK YOU

- The time code is ATRAIN-0000-090148.